

REMARKS

The Examiner has stated several issues regarding the presently claimed embodiment and the Applicants list them below in the order that they are addressed.

- I. The Restriction Requirement is made final.
- II. Claims 2, 12, 21 are rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter.
- III. Claims 21 & 26 are rejected under 35 U.S.C. § 112 ¶ 2 as allegedly failing to particularly point out the claimed embodiment.
- IV. Claims 21-24 and 26-29 are rejected under 35 U.S.C. § 112 ¶ 1 as allegedly failing to comply with the written description requirement.
- V. Claims 1, 6, 11, 16, and 21 are allegedly objectionable.

I. Applicants Request Reconsideration Of Restriction Requirement Finality

The Examiner states that “Applicant’s traversals have been carefully considered but are deemed unpersuasive … [and] … This restriction is made FINAL. *Office Action* pg 2-3. The Applicants disagree for the reasons carefully explained in the Restriction Requirement response, wherein the Examiner’s Restriction Requirement was timely traversed.

The Applicants disagree with the Examiner’s explanations as to why the Applicants arguments are allegedly non-persuasive. Specifically, on what basis does the Examiner make the assertion that:

While the Office may have had the discretion to examine up to ten independent sequences in the past, Office resources can no longer support such searches.

Office Action pg 2. Searching a database takes only minutes and the Applicants suggest that the Examiner has already taken more time in detailing this Restriction Requirement

than it would to perform these searches.¹ Further, the Examiner has provided no cited authority on which to base this new policy. The Applicants' believe that an Examiner does not have any power to modify established MPEP policies and practices.

The Applicants, therefore, respectfully request the Examiner reconsider the Restriction Requirement.

II. The Claims Are Directed To Statutory Subject Matter

The Examiner states that Claims 2, 12, and 21 are "... directed to an unpurified RNA transcribed from the DNA of Claim 1, reads on a product of nature". *Office Action* pg 4. The Applicants disagree because dependent Claims 2 & 12 include all elements of their respective independent Claims 1 & 11, therefore, the transcribed RNAs in Claims 2 & 12 are in a purified condition. It is well established patent law that purified naturally occurring compounds are patentable subject matter and do not read on a product of nature as intended by 35 USC § 101. Additionally, Claim 21 is also not dependent from Claim 1, but is an independent claim in its own right and already directed to "A purified *Bta1* nucleic acid ...". For this reason, the Applicants argue that the Examiner's rejection of Claim 21 is erroneous and therefore moot.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 2 & 12 to recite "Purified RNA ...". This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants respectfully request the Examiner to withdraw the present rejection.

III. The Claims Comply With 35 U.S.C. § 112 ¶ 2

The Examiner believes that the term "DGTS synthetic activity" in Claims 21 and 26 is unclear. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claims 21 and 26 to recite "capable of synthesizing DGTS". This amendment is made not to

¹ Alternatively, perhaps the Examiner is suggesting that the USPTO has the authority to ignore the law at the discretion of an Examiner's "personal opinion" as to what constitutes a lack of Office resources.

acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner also believes that the term "oligonucleotide" in Claim 1 is limited by those having skill in the art to "short" nucleotide sequences. The Applicants disagree. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 1 to recite "nucleotide sequence". This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants respectfully request the Examiner withdraw the present rejection.

IV. The Claims Comply With 35 U.S.C. § 112 ¶ 1

The Examiner states that Claims 21-24, 26-29 are rejected as allegedly failing to comply with the written description requirement because "... the Applicant does not disclose a representative number of species as encompassed by these claims ...". *Office Action, pg 5*. The Applicants disagree because written description requirements are not limited to "a representative number of species". Written description may also be fulfilled by having "common structural features" as recited by high stringency hybridization to SEQ ID NO NO:44 and/or SEQ ID NO:49. *Regents of the University of California v. Eli Lilly and Co.*, 119 F.3d 1559, 1569 (Fed. Cir. 1997).

The Applicants, therefore, respectfully request the Examiner to withdraw the present rejection.

V. The Claims Are Not Objectionable

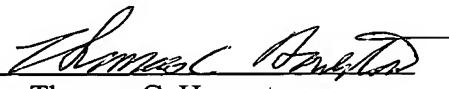
The Examiner noticed a typographical error in Claim 16. The Applicants have corrected the dependent claim reference and thank the Examiner for pointing this out.

The Examiner also requests removal of language drawn to non-elected sequences in Claims 1, 11, and 21. The Applicants disagree for the reasons specified above regarding the reconsideration of the Restriction Requirement.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and objection. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

Dated: August 16, 2006

By: 
Thomas C. Howerton
Reg. No. 48,650

Medlen & Carroll, LLP
101 Howard Street, Suite 305
San Francisco, CA 94105
617.984.0616